

REMARKS

Claims 1-5 and 7-21 are pending. Claims 1-5 and 7-21 are rejected in the Final Office Action mailed December 27, 2005. Claim 16 has been amended to more clearly define Applicant's claimed invention. The Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Since all of the pending claims are in condition for allowance, the Applicant requests allowance of claims 1-5 and 7-21, and forwarding of the application to issuance.

In the Office Action mailed December 27, 2005, the Examiner has rejected claims 18 and 21 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The rejection appears to misconstrue the claimed subject matter of claims 18 and 21 as reciting electrically powered movement of the manipulation members. While this may be one alternative reading it is incorrect. Applicant's claims do not require powered movement of the manipulation members by the power supply. Rather, the leads transmit (manual) motion to the manipulation members. Thus, the claimed subject matter is clear and fully supported in the original disclosure. Regarding claims 18 and 21, an example of supportive written description may be found, *inter alia* at paragraph [0068] of specification. Accordingly, the undersigned requests reconsideration and withdrawal of this rejection.

The Examiner has rejected claims 16 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite. The undersigned notes that the metes and bounds of the claimed subject matter of claims 16 and 17 is clear. However, to expedite prosecution, the undersigned has amended claim 16 to more clearly define Applicant's

claimed subject matter. However, this amendment does not affect the scope of claim coverage, but merely serves to correct asserted informalities.

The Examiner has rejected claims 1-5, 7, 9, 10, 11, 13-15 and 19-20, under 35 U.S.C. §103(a), as being unpatentable over Marucci *et al.* (U.S. Patent No. 6,582,451) alone. The Applicant traverses this rejection and requests reconsideration, withdrawal of the rejection, and allowance of Applicant's application for patent.

As noted in Applicant's prior Response, filed September 22, 2005, the Office Action appears to have misconstrued the Marucci *et al.* patent, and resultantly misapplied it to the claimed subject matter. In addressing Applicant's claimed subject matter, the Office Action relies on column 6, lines 33-40 of Marucci *et al.* However, this portion of Marucci *et al.* does not teach, disclose, nor render obvious the features recited in Applicant's claim 1. In particular, Marucci *et al.* discloses that in one embodiment, "the jaw members may act as platforms for diagnostic or therapeutic modalities including but not limited to: ultrasound, lithotripsy, radiotherapy, radiofrequency, unipolar/bipolar electrocautery".

The Applicant respectfully resubmits that there is a significant difference between the manipulation members comprising a pair of electrodes and the jaws acting as "platforms" for these various therapeutic modalities. Applicant's claims are not reciting that the manipulation members are platforms (i.e., supports) for electrodes, but rather that the manipulation members comprise electrodes.

Moreover, the Office Action as written contradicts itself. Specifically, the Office Action attempts to equate Marucci *et al.*'s connecting member 24 and 25 to the claimed spacer, and Marucci *et al.*'s jaw structure 12 to Applicant's claimed pair of manipulation

members. The interpretation of Marucci *et al.* set forth in the Office Action is incorrect because it proposes that the jaw structure 12 may have a pair of manipulation members that include electrodes, while at the same time electrically insulating connecting members 24 and 25. The Applicant submits that if the connecting members 24 and 25 are insulated, as proposed by the Office Action, then the entire jaw structure 12 would also be insulated as is clear from Fig. 1a (the jaw members 15a and 15b would be conductively isolated by the supporting members 24 and 25 from the rest of the Marucci *et al.* assembly, under the asserted interpretation). Thus, the jaw members 15a and 15b could not function as electrodes. Hence, it is clear that the Office Action has misconstrued the Marucci *et al.* patent and its teachings.

Accordingly, the Applicant again submits that there is no disclosure or teaching of this explicitly recited feature (in the claimed combination) in Marucci *et al.* Accordingly, for this reason alone, it is respectfully resubmitted that claim 1 is clearly patentable over Marucci *et al.*

Independently of the above, Applicant's claim 1 further recites that the spacer insulates the electrodes from each other. There is additionally no teaching or disclosure of this feature in the relied upon Marucci *et al.* reference. In this regard, as Applicant noted above, Marucci *et al.* merely discloses that the electrodes can be platforms for a therapeutic modality such as electrocautery. However, because according to the teachings of Marucci *et al.*, the jaws (or manipulation members) are not the electrodes, there is no reason whatsoever for the spacer (which the Examiner reads on the linkage 24, 25) to comprise an insulating material.

In direct contrast, since in Applicant's invention, the manipulation members comprise the electrodes, the spacer must insulate them from each other in order to avoid short circuiting the manipulation members.

In this regard Applicant notes the Office Action's reliance on column 12, lines 36-41 regarding the use of various plastics. However, because of the recited features of Applicant's invention, the spacer must be an insulator while the electrodes must be conductive. The cited portion of Marucci *et al.* merely indicates that the components of the device may be formed of appropriate materials including stainless steel, atraumatic plastic, or one of various alloys. Further, Marucci *et al.* discloses that, in the alternative, "the device may be manufactured such that each component is made up of a different material to the others". However, such a broad disclosure is merely an invitation to one of ordinary skill in the art to invent and is not a disclosure that anticipates or renders unpatentable the specific recited features of Applicant's invention.

Independently of the above, claim 1 recites the manipulation members are "pivotally" supported by said shaft. However, in Marucci *et al.*, the jaws do not pivot about the shaft (28 according to the Office Action) but moving parallel to each other via the parallelogram linkage 24, 25. In an attempt to read the reference on Applicant's claimed subject matter, the Office Action asserts "that the jaws (12) in fig. 1e (open position) and then fig. 1g (closed position) do indeed pivot around the shaft (28) *through linkage 25.*" See page 9 of the above noted Office Action. However, what these illustrations show is that the jaws 12 move with the same angle of approach with respect to each other and with respect to the shaft (28 according to the Office Action), but do not pivot as required.

With respect to claim 19, the Office Action presents the argument that members 24 and 25 in Marucci *et al.* are fixedly positioned with respect to the support 11. The Applicant respectfully disagrees. Supporting members 24 and 25 pivot and move with respect to support 11 and are therefore not fixedly positioned. Accordingly, it is respectfully submitted that claim 19 is clearly patentable over the Marucci *et al.* reference relied upon by the Office Action. An action to such effect is respectfully requested in due course.

The Examiner has rejected claims 8 and 12, under 35 U.S.C. §103(a), as being unpatentable over Marucci *et al.* (U.S. Patent No. 6,582,451) in view of Mayenberger (U.S. Patent No. 5,853,412). The Applicant traverses this rejection and requests reconsideration, withdrawal of the rejection, and allowance of Applicant's application for patent.

The Applicant respectfully submits that this rejection is improper for at least the reasons discussed above with respect to claim 1. The Applicant further submits that the members 24, 25 (as proposed by the Office Action) are not insulating, and therefore there would have been no reason to make them from ceramic in Marucci *et al.* as proposed by the Office Action.

On a further note, it appears that the Office Action has misapplied the teachings of the MPEP 2111.03 in this case. First, Applicant notes that the MPEP is not binding law, but a guidebook to be followed by patent examiners in performing their daily functions. That having been said, MPEP Section 2111.03 instructs patent examiners that they should read transitional terms, such as "comprising," in **claimed subject matter** as open-ended, inclusive terms. Here, the Office Action appears to misapply

this guidance and interpret it as an instruction to the Examiner to interpret the **reference** as an open-ended, inclusive reference to which one may add subject matter as he or she so chooses. This interpretation of the MPEP is clearly erroneous.

Next, the Office Action appears to have misapplied the letter of the law, *i.e.* 35 U.S.C. §103, and the relevant case law. It appears that the Office Action equates broad disclosure language in the Marucci *et al.* patent as a license to the Examiner to modify the reference in any manner he so chooses, with a total disregard for the requirements established by the Supreme Court in *Graham v. John Deere*, for example. This is clearly erroneous. What the Office Action fails to appreciate is that the burden of presenting a *prima facie* case of obviousness falls on the Office. And, the Office has not met its burden.

For each of the above reasons and certainly for all of the above reasons, it is respectfully submitted that claim 1 is clearly patentable over the Marucci *et al.* reference relied upon by the Examiner in the outstanding Official Action.

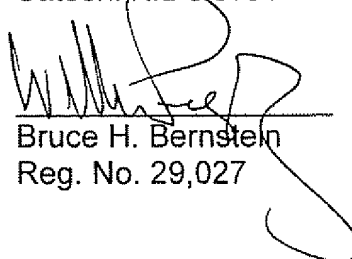
SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended claim 16 to address a language inconsistency raised by the outstanding Office Action. Applicant has pointed out the significant and substantial shortcomings of the references relied upon by the Examiner with respect to the pending claims. Applicant has further discussed the explicitly recited features of Applicant's claims and has noted the shortcomings of the relied upon references with respect thereto. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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